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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,638	03/17/2004	Thomas Glenn Madle	A01508	4919

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ROHM AND HAAS COMPANY  
PATENT DEPARTMENT  
100 INDEPENDENCE MALL WEST  
PHILADELPHIA, PA 19106-2399

EXAMINER

SASTRI, SATYA B

ART UNIT PAPER NUMBER

1713

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,638	<b>Applicant(s)</b> MADLE ET AL.	
	<b>Examiner</b> Satya B. Sastri	<b>Art Unit</b> 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/04, 6/17/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to application filed on March 17, 2004. Claims 1-10 are now pending in the application.

#### *Claim Rejections - 35 USC § 102 and 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7, 8 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 60221469A ('469, DERWENT ABSATRCT).

Prior art to '469 concerns room temperature curing aqueous solution prepared by copolymerizing 5-98% of an acrylic monomer prepared by reacting (A1) unsaturated fatty acid containing 2 or more conjugated double bonds with (A2) a methacrylic ester containing –OH group, (B) 20-40% of unsaturated carboxylic acid and (C) 0-93% of other unsaturated monomers.

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Instant claims recite a product made by a different process. It is the examiner's position that absent evidence on criticality of the claimed process, instant aqueous compositions read on compositions disclosed in the prior art. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. In *re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed and not on the method by which it is produced. In *re Thorpe*, 227, USPQ 984 (Fed. Cir. 1985).

5. Claims 1, 2, 7, 8 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 59152965A ('965, Machine Translation).

'965 discloses an aqueous resin emulsion comprising copolymer composed of 2-60 wt.% of a fatty acid modified monomer and 98-40% of copolymerizable ethylenically unsaturated monomer. Fatty acid modified monomer is obtained by the reaction of drying and/or semidrying oil fatty acid and a glycidyl ester of an  $\alpha$ ,  $\beta$  unsaturated acid (claim 1). Additionally, working example discloses the copolymer composition recited in instant claims.

Instant claims recite a product made by a different process. It is the examiner's position that absent evidence on criticality of the claimed process, instant aqueous compositions read on compositions disclosed in the prior art. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. In *re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product

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formed and not on the method by which it is produced. In re Thorpe, 227, USPQ 984 (Fed. Cir. 1985).

6. Claims 1-4, 6-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 4105134 C ('134, DERWENT ABSTRACT).

The prior art to '134 discloses a process for the production of an aqueous emulsion polymer (I) by (a) normal solution polymerization of (a1) an adduct of unsaturated fatty acid and glycidyl (meth)acrylate with an acid containing monomer (b), partial neutralization with amines or ammonia and (c) normal emulsion polymerization of the product with a combination of styrene and/or MMA to give the emulsion polymer I.

Instant claims recite a product made by a different process. It is the examiner's position that absent evidence on criticality of the claimed process, instant aqueous compositions read on compositions disclosed in the prior art. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed and not on the method by which it is produced. In re Thorpe, 227, USPQ 984 (Fed. Cir. 1985).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4105134 C ('134) in view of Saunders et al. (US 4,482,691).

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Prior art to '134 is presented above in paragraph 6 and is incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not teach the use of drier salts in the composition.

The secondary reference discloses drier salts for air curing of unsaturated oils and alkyd resins are common knowledge to a skilled artisan (column 3, lines 44-52). Such drier salts are useful for the purpose of catalyzing the film formation process. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include drier salts in the aqueous compositions of '134 and thereby obtain the instant invention.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,242,243 discloses a non aqueous composition comprising the copolymer recited in instant claims.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.


The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SATYA SASTRI

June 14, 2006

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700